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MADSON & AUSTIN 15 WEST SOUTH TEMPLE SUITE 900 SALT LAKE CITY, UT 84101			HAILU, TADESSE	
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			2173	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/928,856	Applicant(s) VIGIL ET AL.	
	Examiner Tadesse Hailu	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-19, 23-34 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-19, 23-34 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment submitted/entered February 13, 2006 for the above identified application number.

Status of the claims

2. The pending claims 1-3, 7-19, 23-34, and 37-40 are examined herein as follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7, 8, 13-19, 23, 24, 29-34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (US Pat No. 6,908,389) in view of Martin (US Pub No. 2002/0174106 A1).

With regard to claim 1:

Puskala discloses a hand-held wireless telecommunications device (Fig. 2, #10) configured to send a text message to a recipient (20) through use of a global computer network (30, 43), the wireless device (10) comprising:

a processor (50);

an input component (60) in electronic communication with the processor for a user to enter user input, wherein the input component may be, for example, a keypad or a keyboard for entering textual information (column 1, lines 54-56, column 3, lines 25-27, column 6, lines 18-24).

a display (52) in electronic communication with the processor that displays information to the User;

a communications module (54) in electronic communication with the processor for communicating with the global computer network;

memory (56) in electronic communication with the processor for storing data;

a messaging module (62) comprising instructions that are executable by the processor for implementing a method comprising:

connecting (15) the wireless device to the global computer network (Fig. 1);

displaying (column 12, lines 18-28) network data received from the global computer network on the display (e.g., Figs. 5b, 5C);

enabling the user to establish communications with a message web site (column 4, lines 27-59);

providing to the user a message user interface to select a message from a plurality of predefined ("preconfigured") messages (see Table 1), column 10, lines 5-column 10, lines 25), each of the plurality of messages being predefined to be sent to a recipient, wherein the

messaging module receives the plurality of predefined messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of predefined messages (column 11, lines 27-58);

providing to the user (e.g., wireless device 10) a recipient user interface (e.g., list menu, Fig. 7B) to select the recipient (column 4, lines 12-15); and

sending (e.g., via communication link 15) the message to the recipient (e.g., wireless device 20) through the global computer network (column 11, lines 27-28).

While Puskala discloses memory (56) in electronic communication with the processor for storing data, but Puskala does not explicitly disclose that “the data comprises at least one token”. Also while Puskala discloses a messaging module (62) comprising instructions that are executable by the processor for implementing the “providing” method step above, but Puskala does not explicitly disclose that “at least one of the messages is a text message that includes at least one token”.

Puskala also fails to disclose “the messaging module allows the user to enter token text to replace the at least one token in the message” as claimed in the “message module” of claim 1. Martin, however, discloses a connector (a software component) that includes a template, which may include some specific actions/text, and placeholder tokens for data to be added by the user. Placeholder tokens are the vehicle by which user input and “real time” data and context are transferred from a

client to an agent. For one embodiment, placeholder tokens also determine when a connector is selected (Par. 65). The placeholder tokens are replaced with their associated data. Placeholder tokens may include run time data such as current date, current time, client id, user input arguments, categories, etc. This data is characterized as anything that would logically need to be chosen by a client (as opposed to static reference data). The client includes all potential placeholder tokens and has routines that can supply the correct replacement data (Par. 77).

Puskala and Martin are analogous art because they are from the same field of endeavor, text information processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the user defined message by selecting *4 – USER DEFINED MSG at screen 74, Fig. 5A (col. 9, lines 38-39) of Puskala with a user editable placeholder token of Martin so that the number of clicks required by the user interface is kept to a minimum (Puskala, col. 9, lines 38-38-44). Also as suggested by Martin, one only has to replace the placeholder token, instead of rewritten the whole text messages, thus, similar to Puskala and the current invention the number of clicks required by the user interface may be kept to a minimum (paragraphs 65, 66, 70, 77 and 78).

Therefore, it would have been obvious to combine Puskala with Martin to obtain the invention as specified in claim 1.

With regard to claim 2:

Puskala in view of Martin further discloses that said hand-held wireless telecommunications device is a mobile telephone (Fig. 2).

With regard to claim 3:

Puskala in view of Martin further discloses that said hand-held wireless telecommunications device is a personal digital assistant (column 4, lines 30-31).

With regard to claim 7:

Puskala in view of Martin further discloses that said message is at least an electronic mail messages (column 1, lines 12-15).

With regard to claim 8:

Puskala in view of Martin further discloses that said network data comprises Wireless Markup Language (WML) (column 6, lines 35-36).

With regard to claim 13:

Puskala discloses a web site (Fig. 1) for editing and storing preconfigured messages to be used with hand-held wireless telecommunications devices (e.g., devices 10 and 20), the web site comprising:

a web server (Fig. 1, column 8, lines 51-63) for serving web data to a plurality of wireless devices;

a computer (server at game platform 40, Fig. 1) enabling operation of the web server, the computer being in electronic communication with a storage device (Fig. 3, column 6, lines 45-column 7, lines 6) storing instructions executable by the computer for implementing a method comprising:

allowing a wireless device to contact the web site via a global computer network (column 4, lines 12-20);

receiving from the wireless device (e.g. device 10 or 20) user identification (column 2, lines 23-46);

sending an address list identified through use of the user identification from the web site to the wireless device (column 9, lines 5-47);

sending a plurality of preconfigured messages identified through use of the user identification from the web site to the wireless device, each of the plurality of messages being predefined ("preconfigured") to be sent to a recipient (Figs. 5B-5C, column 9, lines 58-column 10, lines 14);

receiving a message and the recipient from the wireless device, wherein the message is selected from the preconfigured messages by a user through the wireless device, and wherein the recipient is selected from the address list by the user through the wireless device (column 12, lines 18-28); and

sending the message to the recipient through the global computer network (column 1, lines 39-42, column 11, lines 59-column 12, lines 17).

As cited above, while Puskala discloses "a computer enabling operation ..." comprising "sending a plurality of preconfigured messages ...", Puskala, however does not further describe the "sending a plurality of preconfigured messages ...

wherein at least one of the preconfigured messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device". The claimed subject matter is substantially similar to claim 1, thus, Martin, as given rejection to claim 1 above, discloses the claimed subject matter that is missing from Puskala (please see rejection of claim 1). Thus, Puskala and Martin render claim 13 obvious.

With regard to claim 14:

Puskala in view of Martin further discloses storing the preconfigured messages on the storage device (column 2, lines 23-46).

With regard to claim 15:

Puskala in view of Martin further discloses sending user interface data (e.g., menu list, Figs. 5A-5C) to a client computer to present an edit user interface on the client computer; and receiving a change from the client computer to change one of the preconfigured messages (column 7, lines 14-46, column 11, lines 27-58).

With regard to claim 18:

Puskala in view of Martin further discloses that server at platform 40 (web server) serves the web data to a plurality of mobile telephones (column 4, lines 27-59, Fig. 1, 10 and 20).

With regard to claim 19:

Puskala in view of Martin further discloses that server at platform 40 (web server) serves the web data to a plurality of personal digital assistants (column 4, lines 27-59).

With regard to claim 23:

Puskala in view of Martin further discloses that the message is an e-mail message and wherein the method further comprises e-mailing the e-mail message to the recipient through the global computer network (column 1, lines 11-38).

With regard to claim 24:

Puskala in view of Martin further discloses that the web data comprises WML (page 13, lines 15-17).

With regard to claim 29:

Puskala discloses a method for providing predefined ("preconfigured") messages (e.g., see Figs. 5A-5C, table 1) to a hand-held wireless telecommunications device (10) to be sent to a recipient (20) through use of a global computer network (30, 43), the method comprising:

establishing electronic communication between the wireless device (10) and the global computer network (30, 43) (Fig. 1);

establishing electronic communication between the wireless device (10) and a web site storing preconfigured messages (at message database 31), each of the messages being preconfigured to be sent to a recipient (20) (column 2, lines 23-46);

retrieving destination address (address list) from the web site based on user identification (column 8, lines 51-63,);

sending the address list to the wireless device (column 5, lines 1-22, column 8, lines 51-63);

providing to a user (10) a recipient user interface to select the recipient from the address list (column 5, lines 1-22, column 8, lines 51-63);

retrieving the preconfigured messages from the web site based on user identification (column 5, lines 1-22, column 8, lines 51-63, column 12, lines 18-28);

sending the preconfigured messages to the wireless device (column 11, lines 59-column 12, lines 17);

providing to the user a message user interface to select a message from the preconfigured messages (Figs. 5A-5C, table 1, column 10, lines 14-29); and

sending the message to the recipient through the global computer network (column 1, lines 39-42, column 11, lines 59-column 12, lines 17).

While Puskala discloses “establishing electronic communication between the wireless device and a web site” as cited above, but Puskala does not further describe “wherein at least one of the messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device” . furthermore while Puskala describes “providing to the user a message user interface” but Puskala does not describe far enough to teach “the message includes a token, the message user interface allows the user to input token

text”. But the combined art of Puskala and Martin render claim 29 obvious (see claim 1 rejection).

With regard to claim 30:

Puskala in view of Martin further discloses providing a client user interface (e.g., menu list, FIG. 5A-5C) to a client computer via the global computer network (30, 43) to enable the creation of the preconfigured messages that are stored (31) on the web site (column 5, lines 1-22).

With regard to claim 33:

Puskala in view of Martin further discloses that the wireless device is a mobile telephone (Fig. 2, #10).

With regard to claim 34:

Puskala in view of Martin further discloses that the wireless device is a personal digital assistant (column 4, lines 20-31).

With regard to claim 37:

Puskala in view of Martin further discloses that the recipient user interface and the message user interface comprise WML instructions (column 6, lines 35-36).

With regard to claims 16, 17, 31, and 32:

Puskala in view of Martin discloses personal information data, such as destination database 32 at the game platform 40 and another destination database 65 at the wireless device. The destination databases 65 and 32, for example stores the predefined destination address of each player (column 5, lines 58-67). The

wireless device user (e.g., device 10 or 20) is allowed to edit or modify the destination address 65. The wireless device user (e.g., PDA or device 10) also receives the pre-selected or predefined destination addresses from the host (game platform (40)) via the Internet and mobile network 30 (column 2, lines 23-46).

4. Claims 9-12, 25-28 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (US Pat No. 6,908,389) in view of Graham (US Pub No. 2002/0178353 A1)

With regard to claims 9-12, 25-28 and 38-40:

Puskala in view of Martin describes customized application-specific software, which may be written in a language such as wireless markup language (WML) or Java, and alternatively, Puskala in view of Martin describes the messaging application 62 may comprise web access software (column 2, lines 23-46). But Puskala in view of Martin does not describe all HTML-compliant description languages, such as HTML, XHTML, HDML, and XML. However, Graham describes HTML, XHTML, HDML, and XML (see paragraph 32) as recited in the above claims.

Puskala, Martin and Graham are analogous art because they are from the same field of endeavor, electronic messaging. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the HTML-compliant description languages with WAP browser software of Puskala in view of

Martin's. The suggestion/motivation for doing so would have been to provide a WAP user to browse HTML-complaint content using the mobile phone effectively.

Therefore, it would have been obvious to combine Puskala in view of Marin with Graham to obtain the invention as specified in claims 9-12, 25-28 and 38-40:

Response to Arguments

5. Applicants' Remarks/Arguments respect to claims 1, 13, and 29 have been considered but are not persuasive.

The Applicants' argument: The Applicants argue that Puskala does not disclose the amended elements of claims 1, 13, and 29. The Applicants argue Puskala does not disclose, teach, or suggest that "at least one of the ... messages is a text message that includes at least one token," as recited in claims 1, 13, and 29. The applicants further argue Puskala does not disclose that "the messaging module allows the user to enter token text to replace the at least one token in the message," as recited in claim 1 or that "at least one token is editable by the user using the wireless devices" as recited in claims 13 and 29.

The Examiner response: in contrast to the applicants' argument Puskala in view of Martin teaches the placeholder tokens that are edited, replaced with their associated data by the user (Martin, Par. 77).

The Applicants' argument: The Applicants further state and argue that in addition to not disclosing, teaching, or suggesting these claim elements, Puskala teaches away from their inclusion or use. Therefore, because Puskala teaches away

from these claim elements, Puskala cannot be combined with Martin to render claims 1, 13, and 29 unpatentable.

The Examiner response : In contrast to the applicants' argument Puskala in view of Martin is directed to the same invention as the current invention, Puskala in view of Martin also teaches the placeholder tokens that are edited, replaced with their associated data by the user (Martin, Par. 77). Both the current invention and the prior art of records (Puskala and Martin) are directed in minimizing the user entry when manipulating a message sing placeholder token. The incorporation of said token minimizes the number of clicks required by the user interface when manipulating a message.

The Applicants' argument: The Applicants further state the examiner's motivation is in direct conflict with Puskala. Puskala discloses predefined messages for wireless multiplayer gaming. As discussed above, Puskala only discloses predefined messages, not the use of tokens, as recited in claims 1, 13, and 29. The applicants' further state Puskala only discloses predefined messages, because the use of messages that are not defined before gameplay begins would interrupt the game.

The Examiner response: in contrast to the applicants' argument Puskala is not limited to predefined messages as stated by the applicants, Puskala, in addition, discloses user defined messages (column 9, lines 38-44, Fig. 5A, USER DEFINED

MSG). Puskala also discloses that a player can receive messages while offline from the gaming system without interrupting his game (column 8, lines 20-31).

The Applicants' argument: The Applicants further submit their arguments based on the Background teaching of Puskala (page 14 of REMARKS /ARGUMENTS). The Applicants argue Puskala teaches away from any customization of messages during gameplay, because Puskala would lead one skill in that art at the time the invention was conceived "in a direction divergent from the path that was taken by the applicant." The Applicants further state " Because customization requires typing on a numeric keypad, which is "a slow process" that "can interrupt the game," and because the "prepar[ing] a message to be sent will cover a substantial portion, if not all, of the game screen, making it difficult or impossible to see the game while communicating," Furthermore, the Applicants concludes that Puskala clearly teaches away from any customization of its predefined messages including the use of tokens as recited in claims 1, 13, and 29. The applicants further conclude Puskala cannot be combined with Martin or any reference for the purpose of customizing predefined messages especially the use of tokens, as recited in claims 1, 13, and 29.

The Examiner response: the applicants are dubious at best when they base their arguments on the Background disclosure of Puskala. Puskala is an improved invention over what is described in the Background of Puskala's invention. In contrast to the applicants' argument, Puskala disclose modification/customization

of user data, user can edit (via input means) his/her own USER-DEFINED MSG (col. 9, lines 38-44) and send it to the target player. A player can receive messages while offline from the gaming system without interrupting his game (column 8, lines 20-31). Puskala further describes messages will be stored at the wireless device (e.g., at data store 58) of terminals 10 or in message database 31 at the Game-complex 47 (server). The user can then retrieve the stored messages at later time without interrupting the game (column 5, lines 1-33, column 6, lines 14-16).

The Applicants' argument: Regarding to claims 9-12, 25-28, and 38-40, the applicants argue, Puskala does not disclose, teach, or suggest the use of tokens as recited in claims 1, 13, and 29. Likewise, Graham does not disclose, teach, or suggest the use of tokens. the applicants state in fact, even if Graham did disclose, teach, or suggest the use of tokens, the proposed combination would be improper because Puskala teaches away from any customization of its predefined messages.

The Examiner response: these claims are directed to HTML-compliant description languages, such as XHTML, HDML and XML. Graham teaches these elements. The Applicants arguments, however are not directed to these claimed elements, instead the arguments are directed to claims 1, 13 and 29 (see the Examiner response above regarding these independent claims).

Conclusion

6. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. The documents cited, Ballard (US Pat

No. 6,727,916), therein teach a typical wireless device comprising a messaging module as recited in claims 1, 13, and 29. Ballard further describes providing a user a message user interface (Quick Text Choice, e.g., FIG. 6b) to select a message from a plurality of predefined messages, each of the plurality of messages being predefined to be sent to a recipient (see Fig. 6b, wherein device 100 is sending predefined text message to device 102). Mahr (6,956,831) teaches all the limitations of the independent claims (see Figs. 1-6, Abstract, and at least see column 5, lines 1-column 6, lines 16). The Applicant, however, fails to comment on these cited art made of record on form PTO-892.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

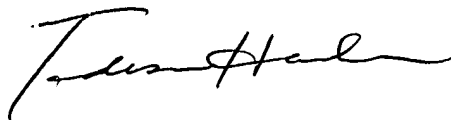
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2173

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:30 – 7:00 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kincaid, Kristine, can be reached at (571) 272-4063 Art Unit 2173 and 2174.

9. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner Tadesse Hailu
Art Unit 2173 – Operator Interface
4/17/06

A handwritten signature in black ink, appearing to read 'Tadesse Hailu', written in a cursive style.